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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,026	04/10/2001	Gary Helms	108298613US	8349

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EXAMINER	
PLUCINSKI, JAMISUE A	
ART UNIT	**PAPER NUMBER**
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/833,026	HELMS ET AL.	
	Examiner	Art Unit	
	JAMISUE A. PLUCINSKI	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5-11,13,15-19,21,22,24,26-32,34 and 36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5-11,13,15-19,21,22,24,26-32,34 and 36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 3, 7, 8, 10, 17, 18, 22, 24, 28, 29, 31, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsuan (US 2002/0116240) in view of Bain et al. (5,315,508).

4. With respect to Claims 1, 11, 22, 32 and 36: Hsuan discloses the use of a method, with computer instructions and system with means for tracking orders or multiple unites of items (see abstract) comprising the means for performing the steps:

a. Providing an order with an order number for a plurality of items (Paragraph 0037);

b. Creating a unit order database (90, order database, with corresponding detailed description) having a record (91) for each unit with a unique article identifier, and contains the order number (link to the order, Paragraph 0037);

c. Wherein creating the unit order database comprises adding a plurality of records (91) for each unit of each item, wherein each record includes an order number and a unique item identifier (See Paragraph 0037); and

d. Setting a status of each unit of each order, when the status changes with the order (Paragraph 0037)

e. It should be noted that the limitation of "when the quantity of units of an item of an existing order has changed, adding records.... and setting records... unit of the item to cancelled" is considered to be conditional limitations of the method claim, and if the quantity of units of an item are never changed, then the method steps do not have to be performed in order for the claim limitations to be met. Hsuan does not disclose the quantity of units to be changed, therefore does not need to satisfy the conditional limitation, and anticipates the claim when the quantity of units does not change.

2. Hsuan discloses the unit order database is formed using the order (such as a file), however fails to disclose the use of the order residing in an existing order database. Bain discloses the use of a purchase order database, where the order database is parsed and a more detailed database is created which is separate from the original/existing order database (Column 7, lines 28-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Hsuan, to have the initial order be in a purchase order database, where the unit order database (more detailed database) is created from the information in the

existing database, as disclosed by Bain, in order to allow for the processing of purchase orders from multiple sources and to simplify the processing of the purchase orders and reduce the likelihood of errors in processing. (See Bain, Columns 1 and 3)

3. With respect to Claims 3, 13, 24 and 34: See Hsuan, abstract, and paragraphs 0037 and 0039.

4. With respect to Claims 7, 17 and 28: Hsuan discloses the updating of the status of the orders are done on a continuous basis (paragraphs 0037 and 0043), which the examiner considers to be a periodic basis.

5. With respect to Claims 8, 18 and 29: The order of Hsuan are tracked on a continuous basis, therefore the examiner considers this to be multiple times a day, which the examiner considers to be done on a daily basis because it is done every day.

6. With respect to Claims 10 and 31: See Hsuan, abstract and paragraph 0038.

7. With respect to Claim 36: See Hsuan abstract.

8. With respect to Claims 9, 19 and 30: Hsuan discloses setting a status in the record, however fails to disclose the status being a shipping status, and ship date. However, the specific type of information that the status is based on is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The creating of database steps and updating status steps would be performed the same regardless of what type of information the status is based on, the claims merely store this information, not use the ship date in any particular fashion, or in any further steps.. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

9. Claims 5, 6, 13, 15, 16, 21, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsuan and Bain et al. as applied to claims 1, 11, 22 and 32 above, and further in view of Peachey-Kountz et al. (6,463,345).

10. With respect to Claims 5, 6, 13, 15, 16, 21, 26, and 27: Hsuan discloses the use of an order and having a record for each item in an order, but fail to disclose the order can be modified to increase or decrease the quantity of the order, and either adding a unit record or setting a record to cancelled. Peachey-Kountz discloses the use of orders where the quantity of items are changed and modified due to backorders or cancellation of orders (see Figures 5-7, Column 11, lines 53-67), and the record status is updated to reflect the change, (see Figures 5 and 6 with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hsuan, to include the capability of changing the order, and the records reflecting the change, in order to provide an improved reporting system. (See Peachey-Kountz, Column 9)

Response to Arguments

11. With respect to Applicant's arguments that the Examiner has disregarded a claim element, and that the courts have stated that "when" does not equate to "if": It should be stated that the examiner did not disregard any claim element, but merely stated that the limitation was a conditional limitation. Looking at the claim… the limitation of when a quantity of units of an item has changed, then records are either added or decreased is not performed every time this method is performed, it is not a guaranteed step of the method, but rather only performed during

certain circumstances, simply because the applicant uses the word "when" does not indicate that it is not a conditional limitation. Prior Art can still read on the claim, if the quantity is never changed. If the quantity of units is never changed, then the step of adding a record or setting a record to being cancelled is not required to be performed. The applicant has argued that "when" is mandatory and not conditional and means "at the time of". However, if that time never comes, then the prior art can still read on the remaining claim. Given the broadest reasonable interpretation with the way the applicant has written the limitations, the examiner is giving the term "when" as written in the claims to be a conditional limitations (when a happens, then perform step b). It should also be noted that if the term "when" is given this strict of a meaning of the step must happen, then in order for the claims to be infringed, the quantity of items "must" change. So any method out there being performed where the quantity changes would not infringe the claims. And if the quantity of the order is never changed, then the method cannot be performed, because the quantity has to be changed in order for the method to be performed.

12. The arguments are not considered to be persuasive and the rejection stands as stated above.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629